

REMARKS

In the Office Action,¹ the Examiner:

- (1) rejected claims 1, 3, 5-11, 14-16, 18, 25, 27, 29, 30, 32-37, and 39-46² under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,424,438 to Vianello (*Vianello*) in view of U.S. Patent No. 7,283,951 to Marchisio et al. (*Marchisio*), U.S. Patent Application Publication No. 2005/0086204 to Coiera (*Coiera*), and U.S. Patent Application Publication No. 2002/0052894 to Bourdoncle et al. (*Bourdoncle*);
- (3) rejected claim 17 under 35 U.S.C. § 103(a) over *Vianello* in view of *Marchisio*, *Coiera*, *Bourdoncle*, and U.S. Patent No. 6,636,837 to Nardoizzi et al. (*Nardoizzi*); and
- (4) rejected claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello* in view of *Marchisio*, *Coiera*, *Bourdoncle*, and U.S. Patent No. 7,392,254 to Jenkins (*Jenkins*).

Claims 1, 3, 5-11, 14-20, 25, 27, 29, 30, 32-37, and 39-46 are pending in this Application.

1. Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejections of: (1) claims 1, 3, 5-11, 14-16, 18, 25, 27, 29, 30, 32-37, and 39-46 under 35 U.S.C. § 103(a) as being unpatentable over

¹ The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

² The Office Action appears to contain a typographical error in Office's summary of the rejections of the claims. (See Office Action at 3.) Specifically, in the summary the Office appears to reject claims that were previously cancelled. Applicant has prepared this response based on the understanding that the inclusion of these claims in the summary was merely a typographical error.

Vianello in view of *Marchisio*, *Coiera* and *Bourdoncle*; (2) claim 17 under 35 U.S.C. § 103(a) over *Vianello* in view of *Marchisio*, *Coiera*, *Bourdoncle*, and *Nardoizzi*; and (3) claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello* in view of *Marchisio*, *Coiera*, *Bourdoncle*, and *Jenkins*.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit and stated that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See M.P.E.P. § 2141. In comparing the claim to the prior art, three factual inquiries must be addressed: (1) the scope and content of the prior art must be ascertained; (2) the differences between the claimed invention and the prior art must be determined; and (3) the level of ordinary skill in the pertinent art at the time of the invention was made must be evaluated. See *id.*

Independent claim 1 recites, in part, “receiving second attributes of the resource through a refinement user interface; *searching the hit-list* for resources having the second attributes; [and] providing a narrowed hit-list of resources having the first and second attributes.”

The Office Action acknowledges that *Vianello* fails to teach or suggest the above-recited elements of independent claim 1. See Office Action pg. 4. However, the Office Action alleges that *Marchisio* remedies this deficiency because *Marchisio* discloses “receiving preference attributes (i.e. second attributes) to filter (i.e. refine) the search

results through a user interface wherein the filtered results (i.e. narrowed hit-list) have attributes of the first search and the preference attributes (See *Marchisio*: Fig. 15 and col. 12, lines 13-42)." (Office Action at 4.) This allegation is incorrect.

Marchisio does not teach the claimed "searching the hit-list" at least because *Marchisio* searches its entire data set, not a hit-list. In particular, *Marchisio* describes a user setting various attributes on a preference window, such as "Country," "Section," "Date" and the like. (See *Marchisio* col. 12, ll. 33-34, Fig. 15.) These attributes are then stored when a user selects a "Set Preferences" button. (See *Marchisio* at col. 12, ll. 34-36.) "When the SQE performs a subsequent natural language query, the results returned are only those sentences found in documents within the data set that relate to the specified attributes." (See *id.* at col. 12, ll. 36-42.) In other words, *Marchisio*'s system conducts a single search of an entire database, and its "filtering" occurs when the results are returned to the user. Searching an entire database and only displaying the results that include an attribute does not teach or suggest searching the claimed "hit-list." Accordingly, *Marchisio* fails to teach or suggest "searching the hit-list for resources having the second attributes" as recited in independent claim 1 and similarly recited in independent claim 25.

Claim 1 further recites (and claim 25 similarly recites) "receiving at least one selected resource type through the refinement user interface; [and] *providing a second narrowed hit-list of resources* having the selected resource type from the narrowed hit-list" (emphasis added). The Office acknowledges that neither *Vianello* nor *Marchisio* teach these elements, and alleges that *Bourdoncle* remedies this deficiency. (See Office Action, pgs. 5-6.) However, this allegation is incorrect.

Bourdoncle does not teach or suggest providing the claimed “second narrowed hit-list” because *Bourdoncle* teaches expanding the hit list. In particular, a user of *Bourdoncle*’s system can conduct a keyword search, and the results of the search can be returned to the user along with the categories in which the results are classified. See paragraphs [0038] and [0067]. When the user selects one of these categories, “the search engine initiates a new search and displays all documents contained in the category” (emphasis added). See paragraph [0067]. Thus, *Bourdoncle* does not teach “providing a narrowed search result having the particular category or type” as alleged by the Examiner. See Office Action, pg. 5. Instead, *Bourdoncle* teaches providing an expanded search result by conducting a new search that displays each and every single document in a particular category. Furthermore, *Bourdoncle*’s results from the narrowed search are not provided “from the narrowed hit-list” as required by the independent claims at least because *Bourdoncle* conducts a new search of the entire database. Providing results of a new search from an entire database is clearly not providing a second narrowed hit-list from the narrowed hit-list. Accordingly, *Bourdoncle* fails to teach or suggest “providing a second narrowed hit-list of resources having the selected resource type from the narrowed hit-list” as recited in independent claim 1 and similarly recited in independent claim 25.

These arguments were presented in Applicant’s previous response and, according to the Office, were persuasive. (See Office Action at 2, stating “Applicant’s arguments, see page 14-15 of Remark[s] . . . are persuasive”; see *also* November 16, 2009 Response at 15, discussing how *Bourdoncle* fails to teach providing the claimed

“second narrowed hit-list.”) Since the Office failed to withdraw the rejection over *Bourdoncle* even though Applicant's arguments were admittedly “persuasive,” Applicant respectfully requests that the Office withdraw the rejection over *Bourdoncle* based on this apparent oversight or, at the very least, provide a complete analysis (as required by the M.P.E.P.) that permits Applicant the opportunity to respond to all of the Office's contentions. At a minimum, Applicant respectfully submits that in view of this discrepancy and/or deficiency discussed above, any further Office Action should be non-final to allow Applicant to address all of the issues raised and fully articulated by the Office, to the extent that the improper rejections are maintained in the next Office Action.

Coiera and *Nardoizzi* fail to remedy these deficiencies at least because these references also fail to teach or suggest the above-recited elements of independent claims 1 and 25.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore a *prima facie* case of obviousness has not been established for independent claims 1 and 25. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claims 1 and 25 under 35 U.S.C. § 103.

Furthermore, Applicant respectfully requests withdrawal of the rejections of claims 3, 5-11, 14-16, 18, 27, 29, 30, 32-37, and 39-46 at least based on their

dependence on one of allowable claims 1 or 25, as well as for the additional elements they recite. For example, claim 42 recites "storing a narrowed collection of resources by selecting a subset of the narrowed hit-list." None of the applied references teaches or suggests this element at least because they do not select a subset of a narrowed hit-list. Accordingly, Applicant respectfully requests withdrawal of the rejection of the dependent claims under 35 U.S.C. § 103. This argument was presented by the Applicant in the previous response, but was also not addressed by the Office. Accordingly, for this additional reason, Applicant respectfully submits that the Office should address Applicants arguments and that any further Office Action should be non-final to allow the Applicant to fully address all of the issues raised and fully articulated by the Office. (See, e.g., M.P.E.P. 707.07(f), stating "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.")

3. **Conclusion**

In view of the foregoing, Applicant requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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